

Remarks

Applicants would like to thank Examiner Bland for withdrawing the previous rejection of claims 1, 2, and 25, under 35 U.S.C. 103(a).

Reconsideration of this Application is respectfully requested. Claims 1, 2, and 25 are pending in the application, with claim 1 being the sole independent claim.

Based on previously presented arguments and the following remarks, Applicants respectfully request that the Office reconsider the currently outstanding rejections, and that they be withdrawn.

Rejection Under 35 U.S.C. § 102

The rejection of claims 1, 2, and 25 under 35 U.S.C. § 102(a) as allegedly being anticipated by Li, H., *et al.*, "NIR Optical Probes Targeting Glucose Transporters," *SPIE Photonic West Meeting*, January 24, 2004¹ ("Li") is respectfully traversed.

The invention disclosed in Li was the inventors' own work, and was not "by another" within the meaning of 35 U.S.C. § 102(a). An applicant's disclosure of his own work within a year before filing cannot be used against the applicant under 35 U.S.C. § 102(a). *See In re Katz*, 687 F.2d 450 (CCPA 1982). Further, where an applicant is a co-author of a publication that is cited against that applicant's application, the publication may be removed by submission of a specific declaration by the applicant establishing that the relevant portions of the publication originated with the applicant. *See id.* The attached Declarations under 37 C.F.R. § 1.132 by Jerry Glickson² and Gang Zheng, both co-inventors of the above-captioned application ("Declarations"), establish that Li was the inventors' own work. Specifically, the Declarations establish that the co-authors: Hui Li, Juan Chen, Min Zhang, Zhihong Zhang, and David Benaron, of the Li reference did not make an inventive contribution to the present application. Accordingly, the Applicants respectfully submit that Li does not qualify as prior art under 35 U.S.C. §

¹ Because of an oversight, our citation of Li in the Information Disclosure Statement ("IDS") filed on November 7, 2007, as being the published on January 27, 2004, is erroneous. The date of publication of Li is January 24, 2004.

² The attached Declaration under 37 C.F.R. § 1.132 by Jerry Glickson is unsigned. Applicants will submit a signed copy of Dr. Glickson's Declaration separately.

102, and therefore cannot be used in a rejection under 35 U.S.C § 102(a). Withdrawal of the preceding 35 U.S.C § 102(a) rejection is therefore respectfully requested.

Rejection under 35 U.S.C. § 103

The rejection of claims 1, 2, and 25 under 35 U.S.C. § 103(a) as allegedly being obvious over Li in view of Fukuzumi, S., *et al.*, "Photophysical and Electrochemical Properties of New Bacteriochlorins and Characterization of Radical Cation and Radical Anion Species," *J. Phys. Chem. A* 106:5105–5113 (2002) and Patani, G.A. and LaVoie, E.J., "Bioisosterism: A Rational Approach in Drug Design," *Chem. Rev.* 96:3147-3176 (1996) is respectfully traversed.

As discussed above, the invention disclosed in Li was the inventors' own work, and was not "by another" within the meaning of 35 U.S.C. § 102(a). The attached Declarations establish that the contents of Li was the inventors' own work. Specifically, the Declarations establish that the co-authors: Hui Li, Juan Chen, Min Zhang, Zhihong Zhang, and David Benaron, of the Li reference did not make an inventive contribution to the present application. Accordingly, the Applicants respectfully submit that Li cannot be used as the basis of a 35 U.S.C. § 103 rejection because it does not qualify as prior art under 35 U.S.C. § 102. Based on the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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